Examiner: Urszula M. Cegielnik
Art Unit: 3712
Telephone: 571-272-4420

Docket No.: NHL-DEL-01-REG
Serial No.: 10/601,839
Fax: 703-872-9306

REMARKS

The Office Action dated May 19, 2004, has been reviewed in detail and the application has been amended in the sincere effort to place the same in condition for allowance. Reconsideration of the application and allowance in its amended form are requested based on the following remarks.

Applicant retains the right to pursue broader claims under 35 U.S.C. §120.

Applicant has provided a unique solution with respect to problems regarding TRACK FOR MODEL CARS. Applicant's solution is now claimed in a manner that satisfies the requirements of 35 U.S.C. §103 and 112.

Allowable Subject Matter:

Claim 2 was indicated as being allowable if rewritten in independent form including all of the limitations of the base claim. Claim 2 was amended accordingly in the Amendment filed August 19, 2004, and is believed to be in condition for allowance. New Claims 5 and 6 are also believed to be in condition for allowance based on

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their dependence from allowable Claim 2.

Rejection of Claim 1 Under 35 U.S.C. §103:

Claim 1 was rejected under 35 U.S.C. §103 as being unpatentable over Nagasaka et al. in view of Simonelli, Smith, III et al, and German Publication No. DE 19819346. However, Claim 1 has been canceled herein, thereby rendering the above rejection moot. However, new independent Claims 7 and 9 have been presented herein, which claims contain similar features as canceled Claim 1 and therefore will be discussed with respect to the present rejection.

As understood, Nagasaka shows a toy race car game which utilizes air blown through holes 20a in the runways 20 to propel the cars around the runways. Triggers 50 are used to increase and decrease the force of the blown air to increase or decrease the speed of the cars. Nagasaka, as stated by the Examiner, does not show a control system having foot-operated clutches, gearshift joysticks, a timer, a sensor at the finish line of each lane, or a light pole.

Simonelli, as understood, shows a race car game where gasoline-powered remote control cars 2, 3 are equipped with forward and rearward video cameras 122, 124. The cameras 122, 124 relay

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video to control booths 4, 5 which simulate the interior of an automobile. The video is displayed on the screen 22 to give the operators a view from the cars 2, 3. The operators use the controls in the booth 4, 5 to "drive" the gasoline-powered remote control cars 2, 3 as one would drive a full-size automobile.

Smith III, as understood, generally shows a toy race car game that is electrically-operated and has a number of components to create sounds and lights to enhance the enjoyment of the toy. Smith III also shows a sensor system for detecting the completion of a lap and the end of a race, among other things. The cars 64 in Smith III have electric motors 65 and are powered by electric current maintained in the track rails 68 and 69.

DE 19819346, as best understood, shows a system for illumination of models, such as model cars and model street lamps using fiber optic technology. As best understood, this reference does not teach or suggest the use of such technology in toy racing car games.

In general, the Examiner stated that it would have been obvious to one having ordinary skill in the art at the time the invention was

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made to include the features of Simonelli, Smith III, and DE 19819346, as discussed on pages 3 and 4 of the outstanding Office Action, in the air-powered car race game of Nagasaka to simulate real race car driving. MPEP 2142 states the following regarding the obviousness of combining two or more references:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In view of these criteria, it is respectfully submitted that a rejection based on the combination of Nagasaka, Simonelli, Smith III, and DE 19819346 would be improper. The second criteria for a *prima facie* case of obviousness requires that there be a reasonable expectation of success in combining the references. It is respectfully submitted that no reasonable expectation of success exists because it would appear that significant portions of the Nagasaka device would have to

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be destroyed, or at least severely compromised, to incorporate the various features of Simonelli, Smith III, and DE 19819346 in order to arrive at the present invention as defined by Claims 7 and 9. Specifically, Simonelli shows a system that uses electronic control systems to send signals to gasoline-powered remote control cars with video cameras attached on top of them to transmit video to the control center to allow the operator to view the cars path of travel. It is extremely unclear how one would simply connect such a complex control system to the toy race car track of Nagasaka. The cars of Nagasaka are very small model cars on a small track that have no individual maneuverability except variations in speed. The cars of Simonelli are much larger gasoline-powered vehicles that are large enough to mount video camera systems on them and are fully maneuverable similar to an actual automobile. So to utilize the system of Simonelli with the race car game of Nagasaka would require major changes to Simonelli or Nagasaka that are not taught or suggested by either reference, and therefore it would be highly unlikely that a combination of such differing systems would be successful. Similarly, it is extremely unclear how the electronic

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systems and sensors of Smith III and the lighting system of DE 19819346 would be incorporated into the pneumatic race car game of Nagasaka. Again, Nagasaka would have to be severely altered or destroyed to incorporate these elements, thereby possibly destroying the race car game as taught by Nagasaka. Therefore, it is respectfully submitted that it could not be reasonably expected that the combination of Nagasaka and Simonelli, let alone including Smith III and DE 19819346, would be even remotely successful.

In addition, it is respectfully submitted that the first criteria for establishing a *prima facie* case of obviousness - that the references provide a motivation or suggestion for the combination - has also not been satisfied. The Examiner does not point out any passage in the Nagasaka reference which would indicate the desirability of adopting any of these features of Simonelli, Smith III, and DE 19819346 in the pneumatic car race game of Nagasaka. Likewise, the Examiner also does not point out any passage in any of the Simonelli, Smith III, and DE 19819346 references which would indicate the desirability, or the utility, of using these features in a pneumatic toy car race game.

In this regard, it is important to note the decision of the Court

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of Appeals, Federal Circuit (CAFC) in its opinion in *In re Howard Sernaker*, 702 F. 2d 989, wherein, a Patent and Trademark Board of Appeal affirmance of an Examiner's rejection under 35 U.S.C. §103, based on a combination of references, was overturned.

In *Sernaker*, the invention involved related to a method for producing embroidered "emblems" which closely resembled emblems of the prior art embroidered with different colored thread. In the claims on appeal, a sculptured embroidery was produced from a single colored thread (e.g., white); a heat-transferable transfer print (e.g., a decal) was provided; the sculptured embroidery and the transfer print were mated and aligned; and color was transferred from the print to the embroidery by the application of heat.

Sculptured one-color embroideries were known in the prior art, as was the heat transferable printing process. However, the CAFC held the claims on appeal nonobvious, stating the relevant tests to be:

> "(a) whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention in suit, and

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(b) whether the claimed invention achieved more than a combination which any or all of the prior art references suggested, expressly or by reasonable combination."

The CAFC recognized that the separate elements of the white sculptured embroidery and the heat-transferable dyeing process existed in the prior art. However, they pointed to the absence, in the references themselves or in the prior art general knowledge as a whole, of any recognition or suggestion that further improvements could be achieved by combining these known elements in the manner taught and claimed in the application (e.g., in a mated and aligned fashion).

It is believed that the decision of *Sernaker* is applicable in the present application, as there is nothing in the references which teaches or suggests that the references be combined.

Further, since there is nothing in the applied references to teach that they be combined, it is also submitted that the only motivation to combine the applied references is the present disclosure itself, and such hindsight analysis of the available art is considered improper. At this juncture, Applicants wish to point out the decision in another court case which is considered to be relevant to the prosecution of

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the instant application.

In *In re Deminski*, 230 USPQ 313 (1986), the CAFC overturned a decision of the Board of Patent Appeals and Interferences regarding obviousness of the invention in view of prior references. In *In re Deminski*, the Board upheld the Examiner's rejection of Claims 17, 18 and 21 in view of obviousness over the prior art. These claims have the limitation that the valve sets in the valve chambers be connected to permit withdrawal as a unit. The Board argued that if the Pocock reference would have attached the valve stem to the valve structure, the valve assembly would have been removable as a unit. The CAFC found nothing in the references to "suggest the desirability, and thus the obviousness" of designing the valve assembly to be removable, and stated that "the only way the board could have arrived at its conclusion was through hindsight analysis by reading into the art Deminski's own teachings. Hindsight analysis is clearly improper, since the statutory test is whether the subject matter as a whole would have been obvious at the time the invention was made."

In view of the above decision in *In re Deminski*, it is submitted that, only upon a reading of the specification of the present

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application that one would have possibly been motivated to combine the pneumatic toy race car game Nagasaka with the features of Simonelli, Smith III, and DE 19819346 described by the Examiner on pages 3 and 4 of the outstanding Office Action.

It is further respectfully submitted that the combination of all four of the applied references forms a "mosaic" or "cookbook" combination of applied references. The combination of this many references would not occur to one of ordinary skill in the art to yield the present invention as claimed except in hindsight analysis, and is therefore improper.

In view of the above, it is submitted that Claims 7 and 9 fully distinguish over and are not rendered obvious by Nagasaka, Simonelli, Smith III, and DE 19819346, either taken singly or in any reasonable combination thereof, and are therefore believed to be allowable. New Claims 8 and 10-23 are also believed to be allowable based on their dependence from Claims 7 and 9, respectively.

Art Made of Record:

The prior art made of record and not applied has been carefully reviewed, and it is submitted that it does not, either taken singly or

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in any reasonable combination with the other prior art of record, defeat the patentability of the present invention or render the present invention obvious. Further, Applicant is in agreement with the Examiner that the prior art made of record and not applied does not appear to be material to the patentability of the claims currently pending in this application.

In view of the above, it is respectfully submitted that this application is in condition for allowance, and early action towards that end is respectfully requested.

Summary and Conclusion:

It is submitted that Applicant has provided a new and unique TRACK FOR MODEL CARS. It is submitted that the claims are fully distinguishable from the prior art. Therefore, it is requested that a Notice of Allowance be issued at an early date.

If mailed, I, the person signing this certification below, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the date indicated in the certification

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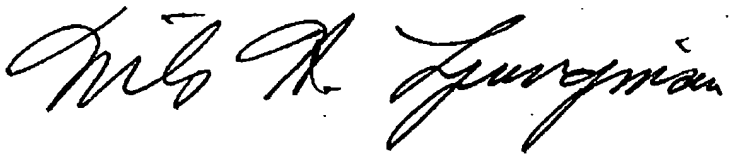
Respectfully submitted,



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